

REMARKS

The Examiner's Action mailed on July 8, 2004, has been received and its contents carefully considered. In this Action, the Examiner has rejected claims 1-4.

In this Amendment, Applicants have editorially amended the specification, amended claims 1-4 and added claims 5-16. Claims 1-16 are pending in the application. For at least the following reasons, it is submitted that this application is in condition for allowance.

The Examiner's Action has rejected claims 1 and 2 under 35 U.S.C. §112, second paragraph. Applicants have above amended claims 1 and 2. Applicants submit that claims 1 and 2, as amended, comply with 35 U.S.C. §112. As such, Applicants request reconsideration and withdrawal of the rejections to claims 1 and 2.

The Examiner's Action has rejected claim 2 as being anticipated by *Goldstein et al.* (WO 99/39176) ("*Goldstein*"). It is submitted that this claim is patentably distinguishable over the cited reference for at least the following reasons.

Applicants' independent claim 2 is directed to a device for capturing biological tissues. Claim 2 recites a working platform, and a biological tissue slide adapted to receive a biological tissue sample thereon. The biological tissue slide is fixed to the working platform in an inverted state, so that the biological tissue sample is disposed between the biological tissue slide and the working platform. Further, a flat sheet tissue sample protecting means is under the working platform, and has a tissue sampling hole therein. The tissue sampling hole is disposed under a cut cell sample. Moreover, a sampling mortar is disposed under the tissue sampling hole. The sampling mortar has a diameter larger than a diameter of the tissue sampling hole, so that when an impact lever moving mechanism provides a force to the

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biological tissue slide, the cell sample drops through the tissue sampling hole and into the sampling mortar.

Thus, unwanted material (e.g., processing materials) that falls towards the flat sheet tissue sampling means is not used and does not fall through the tissue sampling hole. In addition, other contaminants are "caught" by the flat portion of the flat tissue sample protecting means that may inadvertently fall downwards. Thus, Applicants' claimed invention provides for a novel and an inventive way in which desired biological tissue is captured. This claimed biological tissue capturing device is neither disclosed nor suggested by the cited reference.

Goldstein et al. (WO 99/39176) ("*Goldstein*") discloses a laser capture microdissection device for capturing biological tissue samples. Specifically, *Goldstein* discloses a device which dispenses a coated tape 18. The coated tape 18 is above slide 32. When a desired sample is centered within a viewing field, the coating tape 18 is activated by a laser light source 42. The activated coating tape 18 is contacted (using a pressure plate "P") to the desired sample. After adhesion of the desired sample to the coating tape occurs, the coating tape is moved (i.e., pulled upwards from the slide 32). Thus the coating tape acts as a transport substrate. As a result, *Goldstein* requires moving the desired sample twice (i.e., onto the coating tape and then off of the coating tape).

However, and in contrast to the present invention, this cited reference does not disclose or suggest that a biological tissue sample is disposed between a biological tissue slide and a working platform. Instead, the sample S is disposed above the slide 32, and both the slide 32 and the sample S are disposed over the stage (i.e., the "working platform").

Moreover, the cited reference does not disclose or suggest a tissue sample protecting means under a working platform, as recited in claim 2. Instead, the tape 18 (which the Action has held to be a tissue sample protecting means) is disposed over the stage.

Additionally, there is no disclosure or suggestion from this reference that the tape 18 has a tissue sampling hole therein, as recited in claim 2. Although this reference teaches punching out sections 64 from the tape 18, these sections are punched out with the sample sections 34 attached thereto, so that the resulting hole in the tape 18 is not a tissue sampling hole that is disposed under the cell sample.

Further, this reference does not disclose or suggest an impact lever moving mechanism that applies a force to the tissue slide, as recited in claim 2. Instead, the punch 62 applies its force against the tape 18, which the Action has held to be a tissue sample protecting means. Thus, *Goldstein* does not disclose or suggest many of the elements recited in Applicants' claim 2.

At least for the reasons provided above, it is submitted that Applicants' claim 2 is not anticipated by *Goldstein*. It is thus requested that the rejection of claim 2 be reconsidered and withdrawn. Further, Applicants submit that claim 4 and newly added claims 11 and 12 are also allowable at least for their dependency upon allowable claim 2.

The Examiner's Action has also rejected claim 1 as being obvious over *Goldstein*; and claims 3 and 4 as being obvious over *Goldstein* in view of *Dorian et al.* (U.S. Patent No. 5,521,079, issued May 28, 1996) ("*Dorian*"). It is submitted that these claims are patentably distinguishable over the cited references for at least the following reasons.

Claim 1 recites many of the same features discussed above with respect to claim 2, but is presented in a method format. In particular, claim 1 recites placing a biological tissue sample on a biological tissue slide, and after the placing is performed, inverting the biological tissue slide and fixing the biological tissue slide on a working platform, so that the biological tissue sample is disposed between the biological tissue slide and the working platform. In contrast, and as noted above, the cited reference does not

disclose or suggest inverting the slide 32, nor disposing the sample S between the slide 32 and the stage (i.e., the "working platform"). The Action acknowledges this reference does not disclose inverting the slide, but states that this feature would be obvious. However, it is noted that if the slide 32 were inverted, so that that sample S is between the slide 32 and the stage, the sample S would not be in a position to be picked up by the tape 18, thus destroying the functionality of the disclosed device. Thus, this reference teaches away from Applicants' claimed operation.

Further, this reference does not disclose or suggest positioning the slide 32 above the tape 18 (i.e., the "tissue sample protecting means"), nor that the tape 18 has a tissue sampling hole therein, as recited in claim 1. Instead, the tape 18 must be positioned over the slide 32, in order to allow the tape to pick up the sample. Moreover, and as noted above, the tape 18 does not have a tissue sample hole.

Further, the cited reference does not disclose or suggest applying a force to the slide 32 with the punch 62, as would be required by claim 1. Instead, the cited reference teaches applying a force to the tape 18. Further, when the force is applied to the tape 18, this does not cause the cell sample to drop down through the tissue sample hole and into a sampling mortar, as recited in claim 1. As such, Applicants submit that claim 1 is not obvious and fully satisfies the requirements under 35 U.S.C. §103 and is patentable thereunder. In addition, dependent claims 3 and 5-10 (which depend from independent claim 1) are also not obvious, at least for their dependency upon independent claim 1. Therefore, Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection against claim 1.

The Examiner's Action has also recited claims 3 and 4 as being obvious over *Goldstein* in view of *Dorian*.

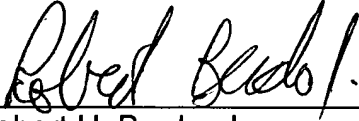
The addition of *Dorian* does not correct the shortcomings of *Goldstein*. Thus, the distinctions presented above with respect to Applicants' invention and *Goldstein* are also applicable with respect to the instant rejection. Because of the dependency of claims 3 and 4 upon independent claims 1 and 2, respectively, Applicants submit that claims 3 and 4 are not obvious in view of *Goldstein* and *Dorian*. It is requested that these claims also be allowed, and that this rejection be withdrawn.

It is submitted that this application is in condition for allowance. Such action and the passing of this case to issue are requested.

Should the Examiner feel that a conference would help to expedite the prosecution of the application, the Examiner is hereby invited to contact the undersigned counsel to arrange for such an interview.

Respectfully submitted,

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Date


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